

# EXHIBIT 12

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6 IN THE UNITED STATES DISTRICT COURT

7 FOR THE NORTHERN DISTRICT OF CALIFORNIA

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9  
10 FINJAN, INC., No. C 17-05659 WHA

11 Plaintiff,

12 v.

13 JUNIPER NETWORKS, INC.,

14 Defendant.  
15 \_\_\_\_\_ /

**ORDER ON SECOND ROUND  
OF EARLY MOTIONS FOR  
SUMMARY JUDGMENT AND  
MOTION TO STRIKE AND  
ORDER TO SHOW CAUSE**

16 **INTRODUCTION**

17 In this patent infringement action, each side moves for summary judgment on one  
18 asserted claim. For the reasons stated below, the patent owner's motion for summary judgment  
19 of infringement is **DENIED**. The accused infringer's motion for summary judgment of non-  
20 infringement and on damages is **GRANTED** to the extent stated below and motion to strike is  
21 **DENIED AS MOOT**. The parties are **ORDERED TO SHOW CAUSE** as to why judgment on the  
22 patent owner's motion should not be entered in favor of the accused infringer.

23 **STATEMENT**

24 Plaintiff Finjan, Inc. alleges that defendant Juniper Networks, Inc.'s products infringe  
25 its patents, including, *inter alia*, United States Patent Nos. 8,141,154 ("the '154 patent") and  
26 6,804,780 ("the '780 patent"). These patents broadly relate to computer malware protection.

27 Pursuant to the second round of early motions for summary judgment, Finjan moves on  
28 infringement of Claim 1 of the '154 patent and Juniper moves on non-infringement of Claim 9

1 of the '780 patent and limitation of damages (Dkt. Nos. 369, 371). Juniper also moves to strike  
2 certain infringement theories related to the '154 patent (Dkt. No. 391).

3 **1. THE '154 PATENT.**

4 The '154 patent is directed toward a system and method “for protecting a client  
5 computer from dynamically generated malicious content” and statically generated conventional  
6 viruses ('154 patent at Abstract). The specification explains that “a newer type of virus”—  
7 namely, “dynamically generated viruses” that are “generated only at run-time”—“take  
8 advantage of features of dynamic HTML generation, such as executable code or scripts that are  
9 embedded within HTML pages” (*id.* at 3:32–38).

10 The specification recounts the disadvantages of “conventional reactive content  
11 inspection and conventional gateway level behavioral analysis content inspection” and  
12 “desktop anti-virus protection” (*id.* at 3:65–4:8, 4:18–22). According to the patent,  
13 conventional gateway level behavior analysis content inspection cannot detect the new type of  
14 virus (*id.* at 3:65–4:1). For example, a content inspector “will only detect the presence of a call  
15 to Document.write( ) with input text [which may involve malicious JavaScript not present in  
16 the content prior to runtime] that is yet unknown” (*id.* at 4:1–4). And, desktop anti-virus  
17 protection must expose its vulnerabilities to hackers, among other disadvantages (*id.* at  
18 4:18–21). The specification then announces that “there is a need for a new form of behavioral  
19 analysis, which can shield computers from dynamically generated malicious code without  
20 running on the computer itself that is being shielded” (*id.* at 4:23–26). To that end, the '154  
21 patent uses a “security computer” to inspect potentially malicious code (*id.* at 4:35).

22 The basic set up of the '154 patent's purported invention involves “[t]hree major  
23 components”: (1) gateway computer, (2) client computer, and (3) security computer (*id.* at  
24 8:45–46). The “present invention operates through a security computer that is preferably  
25 remote from a client computer that is being shielded while processing network content” (*id.* at  
26 4:35–37). A preferred embodiment describes a gateway computer that intercepts content (*e.g.*,  
27 HTML pages, Java applets) being sent to the client computer for processing (*id.* at 8:48–51).  
28 The gateway computer modifies the content by replacing the call to the original function with a

1 corresponding call to a substitute function, which operates to send the input of the original  
 2 function to a security computer for inspection (*id.* at 5:10–12). The gateway computer then  
 3 transmits “the modified content” to the client computer, which processes the modified content  
 4 (*id.* at 5:14–16). When the substitute function is invoked, the client computer transmits the  
 5 input to the security computer for inspection (*id.* at 5:16–18). The security computer then  
 6 inspects the input and transmits “an indicator of whether it is safe for the client computer to  
 7 invoke the original function with the input” (*id.* at 5:20–22). The client computer invokes the  
 8 original function “only if the indicator . . . indicates that such invocation is safe” (*id.* at  
 9 5:22–25). Figure 2 illustrates a “simple topology” of this set up (*id.* at 8:41–44, 62):

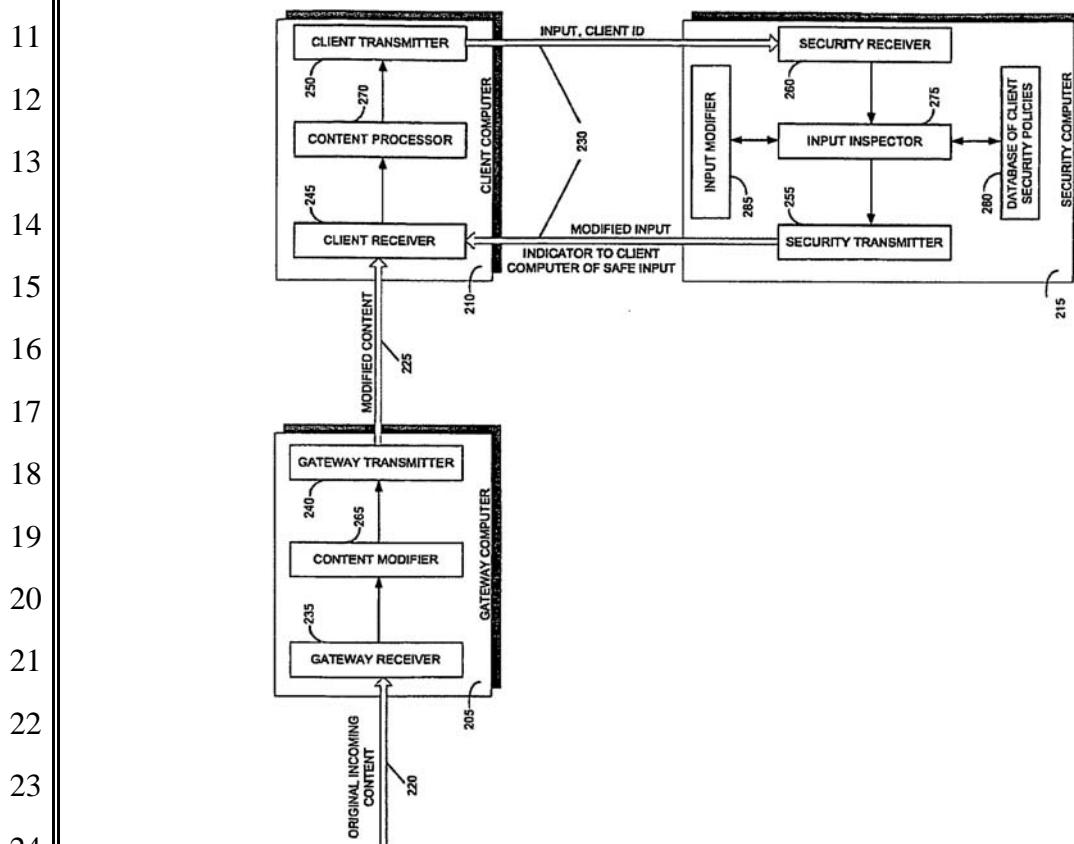


FIG. 2

## 2. THE '780 PATENT.

27 A prior order has described in detail the '780 patent's purported invention (Dkt. No.  
 28 180). The '780 patent describes generation of an ID for a downloadable (“Downloadable ID”)

1 in order to match it against previously encountered suspect downloadables. This saves the  
2 malware-protection system from going through an intensive analysis every time that  
3 downloadable attempts to enter the user's system. The patent discloses an ID generator that  
4 generates a Downloadable ID by fetching components called out by the incoming file, then  
5 running a hash function across the combined code.

6       **3. THE ACCUSED PRODUCTS.**

7           **A. SRX Gateways.**

8 Juniper's SRX Series Gateways ("SRX") are secure routers that can act as firewalls to  
9 protect a computer on a network from receiving malicious content. Once SRX receives  
10 content sent from a network such as the Internet, it blocks data already recognized as  
11 malicious. If SRX does not recognize the content, it will then send it to the cloud-based Sky  
12 Advanced Threat Prevention ("Sky ATP") for analysis.

13           **B. Sky ATP.**

14 Sky ATP, sold as an add-on to SRX, is a cloud-based scanning system that inspects  
15 content with its "Malware Analysis Pipeline" to determine the threat level posed by a  
16 "Downloadable." The Malware Analysis Pipeline scans an unrecognized Downloadable using  
17 static and dynamic analysis. Static analysis involves evaluating the Downloadable's contents  
18 without actually running it. Dynamic analysis evaluates the Downloadable's contents by  
19 executing and observing the file in a safe environment called the "sandbox." The multi-stage  
20 pipeline analysis identifies easily detected malware first (through static analysis), then analyzes  
21 progressively harder-to-detect malware process through the pipeline (ending with dynamic  
22 analysis). This pipeline renders a "verdict," *i.e.*, how dangerous the file is.

23           **C. ATP Appliance.**

24 Advanced Threat Prevention Appliance ("ATP Appliance") — a product previously  
25 sold by Cyphort (which Juniper acquired in 2017) — operates in a manner similar to Sky ATP.  
26 Instead of a cloud-based service, however, ATP Appliance is a local network appliance that  
27 includes "collectors" that capture information regarding network traffic by copying files being  
28 downloaded from the network such as the Internet. The ATP Appliance hashes a copy of a file

1 being downloaded over the network to determine whether the file has already been analyzed.  
2 If the file is not recognized, then it is sent to ATP Appliance’s “SmartCore,” which performs a  
3 multi-stage analysis (including static and dynamic analysis). The results of the analysis are  
4 then sent to the system administrator for future reference.

5 \* \* \*

6 Finjan now accuses the following products of infringing Claim 1 of the ’154 patent: (1)  
7 SRX; (2) Sky ATP; and (3) the Advanced Threat Prevention Appliance (“ATP Appliance”)  
8 (Dkt. No. 369 at 1). Finjan asserts that these products infringe Claim 1 “because they analyze  
9 content received over a network using a security computer for advanced analysis” (Dkt. No.  
10 369 at 2). Juniper opposes, arguing that under its proposed constructions of the terms “content  
11 processors” and “safe,” the accused products do not infringe Claim 1 (Dkt. No. 390 at 13).

12 Juniper also moves for non-infringement of Claim 9 of the ’780 Patent (Dkt. No. 371).  
13 Juniper further moves on the issue of damages — that is, because Finjan allegedly failed to  
14 provide notice of Juniper’s (supposed) infringement of the ’780 patent, Finjan is not entitled to  
15 any damages. Finjan opposes the motion in connection with ATP Appliance only (see Dkt.  
16 No. 393 at 1–2). This order follows full briefing and oral argument.

## 17 ANALYSIS

18 Summary judgment is proper when there is no genuine dispute of material fact and the  
19 moving party is entitled to judgment as a matter of law. FRCP 56(a). A genuine dispute of  
20 material fact is one that “might affect the outcome of the suit under the governing law.”  
21 *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247–48 (1986). In deciding a motion for  
22 summary judgment, the court must accept the non-movant’s non-conclusory evidence and  
23 draw all justifiable inferences in its favor. *Id.* at 255.

### 24 1. FINJAN’S MOTION ON CLAIM 1 OF THE ’154 PATENT.

25 Claim 1 of the ’154 patent reads as follows (’154 patent at 17:32–44):

26 1. A system for protecting a computer from dynamically generated  
27 malicious content, comprising:  
28 a *content processor* (i) for processing content received  
over a network, the content including a call to a first  
function, and the call including an input, and (ii) for

invoking a second function with the input, only if a security computer indicates that such invocation is *safe*;

a transmitter for transmitting the input to the security computer for inspection, when the first function is invoked; and

receiver for receiving an indicator from the security computer whether it is *safe* to invoke the second function with the input.

The contested terms are italicized. Juniper argues that its accused products do not infringe Claim 1 because (1) they do not include the claimed “content processor,” and (2) they do not indicate whether invoking the second function is “safe” (Dkt. No. 390 at 13, 20–23). This order therefore must first construe the disputed terms to determine the scope of Claim 1 before determining whether Claim 1 reads onto Juniper’s accused products.

Claim terms “are generally given their ordinary and customary meaning,” *i.e.*, “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). To properly construe a claim, a court must examine the claim, the rest of the specification, and, if in evidence, the prosecution history. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1324 (Fed. Cir. 2003).

Here, the parties dispute the following terms in connection with the instant motion (Dkt. No. 390 at 5–6):

<b>CLAIM TERM</b>	<b>FINJAN</b>	<b>JUNIPER</b>
Safe	Something that is not potentially harmful or malicious	Security profile does not violate the client computer's security policy
Content processor	Plain and ordinary meaning (a component that processes content)	Plain and ordinary meaning (a processor on a client/user computer that processes modified content)

Because this order finds construction of “content processor” as dispositive, it need not reach construction of any other term.

1                   **A.        “Content Processor.”**

2                  Both parties assert that they propose the “plain and ordinary meaning” of the term  
3 “content processor.” Of course, both parties disagree as to what the plain and ordinary  
4 meaning of the term actually entails. Juniper argues that a person of ordinary skill in the art  
5 would understand the term — particularly in light of the specification and file history — as “a  
6 processor on a client/user computer that processes modified content.” It further argues that  
7 Finjan’s proposed construction “is redundant and disregards the patent’s express description of  
8 the ‘present invention’ ” (*id.* at 7).

9                  A court may not impose improper limitations from the specification into the claims.  
10 *Phillips*, 415 F.3d at 1323. That being said, the specification is “the single best guide to the  
11 meaning of a disputed term” and “[u]sually, it is dispositive.” *Id.* at 1315 (citation and  
12 quotations omitted). This order concludes that a person of ordinary skill in the art would  
13 understand that the “content processor” in Claim 1 processes modified content.

14                  That the “content” being processed in Claim 1 has been modified is made evident by  
15 the claim language and specification. The United States Court of Appeals for the Federal  
16 Circuit has explained that the ’154 patent “has four independent claims (1, 4, 6, and 10), each  
17 reciting a system or software program that executes a substitute function. . . . In the language  
18 of the ’154 patent, the ‘first function’ is the inspection step in which the content is assessed for  
19 safety, and the ‘second function’ is when, having been deemed safe, the content is actually  
20 run.” *Palo Alto Networks, Inc. v. Finjan, Inc.*, 752 F. App’x 1017, 1018 (Fed. Cir. 2018); *see*  
21 *also Finjan, Inc. v. Cisco Systems, Inc.*, 2018 WL 3537142, at \*20–23 (N.D. Cal. July 23,  
22 2018) (Judge Beth Labson Freeman) (construing the terms “first function” to mean “substitute  
23 function” and “second function” as “original function, which is different than the first  
24 function”). The claimed “first function” then clearly involves the “substitute function,” which  
25 sends the content’s input to the security computer for inspection once invoked. According to  
26 the specification, the substitute function exists only after the original content is modified at the  
27 gateway computer (*see, e.g.*, ’154 patent at 9:13–28). Accordingly, the claimed “content”  
28 necessarily refers to modified content.

1        This reading is made all the more apparent by the '154 patent's own description of the  
 2 "present invention" ('154 patent at 4:55–60):

3        To enable the client computer to pass function inputs to the  
 4 security computer and suspend processing of content pending  
 5 replies from the security computer, *the present invention operates*  
*by replacing original function calls with substitute function calls*  
*within the content*, at a gateway computer, prior to the content  
 6 being received at the client computer.

7        "When a patent [] describes the features of the 'present invention' as a whole, this description  
 8 limits the scope of the invention." *Regents of Univ. of Minnesota v. AGA Med. Corp.*, 717 F.3d  
 9 929, 936 (Fed. Cir. 2013) (quoting *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d  
 10 1295, 1308 (Fed. Cir. 2007)).

11       As Juniper points out, this construction is consistent with the Patent Trial Appeals  
 12 Board's ("PTAB") understanding (under the broadest reasonable interpretation) of Claim 1,  
 13 which understood the '154 patent specification to refer to "three categories of content" (Dkt.  
 14 No. 390-19 at 9 (emphasis added)):

15       First, there is the "original content" that is scanned and modified at  
 16 the gateway computer. Second, there is the "*modified content*"  
*transmitted to, and received by, the client computer*. Third is the  
 17 "dynamically generated malicious content" that is generated at  
 runtime and, thus, is undetected by the gateway computer in the  
 "original content."

18       The PTAB further noted that "[n]otwithstanding the variety of content described in the  
 19 Specification, the term 'content' is recited broadly in all challenged claims as 'content  
 20 including a call to a first function'" (*ibid.*). It then explained that (*id.* at 10 (first emphasis  
 21 and alteration in original, second emphasis added)):

22       Because the recited "first function" is the substituted function  
 23 whose input is verified, the *claimed* "content," in the context of the  
 24 surrounding claim language, must refer to the *modified content*  
*received at the client computer*. See *id.* at 17:39–40 ("transmitting  
 25 the input [of the first function call] to the security computer for  
 inspection, when the first function is invoked"). The claimed  
 26 content cannot refer to the "original content" that is received by  
 27 the gateway computer and over the Internet because that content,  
 according to the Specification, would be capable of generating the  
 undetected dynamically generated malicious content from which  
 the client computer is to be protected.

1 As such, the PTAB concluded that the claimed “content” refers to “data or information, *which*  
2 *has been modified* and is received over a network” (*id.* at 14 (emphasis added)). This order  
3 agrees with the PTAB’s understanding to the extent that it found that the claimed “content”  
4 “has been modified.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996)  
5 (claims are to be construed “in a way that comports with the instrument as a whole”).

6 In light of the foregoing, Finjan’s assertion that Juniper’s proposed construction  
7 “makes no sense in the context of the claims because it would have the content processor  
8 processing both modified and unmodified content simultaneously” is unpersuasive (Dkt. No.  
9 415 at 2). The claimed “content” refers to the modified content, and the content processor  
10 processes that modified content. There is no incongruity.

11 Finjan’s contention that the “modified content” limitation would read out preferred  
12 embodiments is similarly unpersuasive, as it misapprehends the context of those embodiments.  
13 Finjan argues that because the patent “describ[es] that ‘content’ received for processing has the  
14 ‘original’ function,” the content in that embodiment is unmodified (*ibid.* (citing ’154 patent at  
15 6:4–14)). But read in context, the described “content” in that citation containing the “original”  
16 function clearly refers to the (unclaimed) first category of content the PTAB identified — *i.e.*,  
17 the content that is initially “scanned and modified at the gateway computer” before it is  
18 transmitted to the client computer (*id.* at 9). Finjan further points out that the patent describes  
19 a “content processor” “for processing content received over a network,” and thus contends that  
20 this is “an example where unmodified content is processed using a content processor” (*ibid.*  
21 (citing ’154 patent at 7:22–23)). Again, when read in context, that citation clearly refers to the  
22 second category of content identified by the PTAB — *i.e.*, “the ‘modified content’ transmitted  
23 to, and received by, the client computer.” Finjan also recites various examples of unmodified  
24 content disclosed in the specification, such as “HTML web page, XML document, a Java  
25 applet, an EXE file, JavaScript, . . . or any such data container that can be rendered by a client  
26 web browser” (*id.* at 2–3 (citing ’154 patent at 13:49–52)). Again, these examples refer to the  
27 *unclaimed* unmodified content received by the gateway.

1 Finjan also argues that the '154 patent "is explicit when something is 'modified' from  
 2 its original form" (*id.* at 3 (citing '154 patent at 3:9–12)). It further asserts that "the content  
 3 being 'modified' was not intended to be in the claims" because it removed the word  
 4 "modified" from the claim language during prosecution (*ibid.*). That is, Finjan struck out the  
 5 word "modified" from "content" from dependent Claim 2 (Dkt. No. 415-3). While this  
 6 argument has some force, it is ultimately unpersuasive in light of the claim language and  
 7 specification as a whole. Nor is Finjan's citation to other claims that include the word  
 8 "modified" helpful, as those terms refer to modified *input variable*, which is distinct from  
 9 Claim 1's modified *content*.<sup>1</sup>

10 Finjan further asserts that Juniper's expert witness, Dr. Aviel Rubin, had taken an  
 11 inconsistent position during a prior IPR proceeding (Dkt. No. 369 at 7). Specifically, Dr.  
 12 Rubin previously opined that the term "content processor" should be given its plain and  
 13 ordinary meaning (Dkt. No. 390 at 10). This order, however, does not necessarily find the  
 14 inconsistency Finjan complains of. Dr. Rubin testified during the IPR proceeding that he  
 15 interpreted the claim terms the petitioner did not specifically propose for construction  
 16 (including "content processor") under their ordinary meaning "in light of [the '154 patent's]  
 17 specification" (Dkt. No. 389-6 ¶ 23 n.1). He now makes explicit Claim 1's clear implication.  
 18 And, even assuming Dr. Rubin's testimony contains an inconsistency, this order does not find  
 19 it fatal to Juniper's current proposed construction under these circumstances.

20 Finally, this order rejects Finjan's proposition that because another court in our district  
 21 has already construed the term "content processor" under the plain and ordinary meaning, it  
 22 needs no further construction (Dkt. No. 369 at 6). Finjan cites three claim construction  
 23 decisions by Judge Haywood Gilliam Jr., who adopted Finjan's proposed construction (*id.* at  
 24 6–7). Judge Gilliam, however, adopted Finjan's proposed construction because those

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25  
 26 <sup>1</sup> During oral argument, Finjan argued that Juniper's reasoning regarding the substitute function described the claims  
 27 of United States Patent No. 7,757,289 ("the '289 patent"), of which the '154 patent is a continuation, "to a tee" (Dkt. No.  
 28 457 at 21:15–17). This order finds the argument unpersuasive. *First*, Claim 1 of the '154 patent differs from the '289 patent  
 claims in that Claim 1 does not claim the whole system — including the gateway, client, and security computer — as the '289  
 patent does. Claim 1 of the '154 patent as construed thus does not track the '289 patent's claims "to a tee." *Second*, given  
 that the '154 patent is a continuation the '289 patent, significant overlap in the substance of the claims is not surprising.

1 defendants unsuccessfully attempted to either construe the term as a means-plus-function or  
2 limit the term to one specific embodiment. *See Finjan, Inc. v. Proofpoint, Inc.*, 2015 WL  
3 7770208, at \*9–11 (N.D. Cal. Dec. 3, 2015) (rejecting defendant’s construction of “content  
4 processor” as a means-plus-function claim); *Finjan, Inc. v. Bitdefender Inc.*, Case No. C 17-  
5 04790 HSG, 2019 WL 634985, at \*11–12 (N.D. Cal. Feb. 14, 2019) (also rejecting defendant’s  
6 construction of “content processor” as a means-plus-function claim); *Finjan, Inc. v. Symantec  
7 Corp.*, Case No. C 14-02998 HSG, 2017 WL 550453, at \*10–11 (N.D. Cal. Feb. 10, 2017)  
8 (rejecting defendant’s proposed limiting of “content processor” to the specific embodiment  
9 describing “software that renders the content for interactive viewing on a display monitor”).  
10 At no point during those proceedings did Judge Gilliam have the opportunity to address the  
11 specific issues raised in the instant motion.

12 Accordingly, this order construes the term “content processor” as “a processor that  
13 processes modified content.”<sup>2</sup>

14 **B. Accused Products Do Not Infringe.**

15 Under the adopted construction, Juniper’s accused products (SRX, Sky ATP, and ATP  
16 Appliance) do not infringe Claim 1 of the ’154 patent. Finjan offers no evidence that the  
17 accused products’ alleged content processor processes modified content. Rather, the current  
18 record shows that those products process only unmodified content. Specifically, Dr. Rubin,  
19 Juniper’s expert witness, affirmatively declared that “the accused products and the technology  
20 claimed . . . do not modify or ‘instrument’ content; as a result, they all process unmodified  
21 content received from the web server” (Dkt. No. 390-1 ¶ 38; *see also id.* at ¶¶ 28, 31, 34).  
22 Because the foregoing construction excludes SRX, Sky ATP, and ATP Appliance from  
23 infringement for this reason, Finjan’s motion for summary judgment of infringement of Claim  
24 1 of the ’154 patent is **DENIED**.

25  
26  
27  
28 <sup>2</sup> In construing the term “content processor,” this order finds the issue of “processing modified content” dispositive  
to this instant motion. Therefore, though Juniper makes a strong argument for the proposition that the content processor  
resides on the *client* computer, this order need not and does not reach that issue in construing the term.

1           In light of the foregoing, even though Juniper did not itself cross-move for summary  
 2 judgment on Claim 1 of the '154 patent, both sides are **ORDERED TO SHOW CAUSE** in writing  
 3 by **MAY 13 AT NOON** why summary judgment should not be granted in favor of Juniper with  
 4 replies by **MAY 16 AT NOON**.

5           **2. JUNIPER'S MOTION ON CLAIM 9 OF THE '780 PATENT.**

6           The '780 patent makes yet another showing in the second round of early motions for  
 7 summary judgment. During the first round, a prior order found that Juniper's SRX and Sky  
 8 ATP products did not infringe Claim 1 of the '780 patent after construing the term "performing  
 9 a hashing function on the Downloadable and the fetched software components to generate a  
 10 Downloadable ID" (Dkt. No. 180 at 10).

11          Juniper now moves for summary judgment of non-infringement on Claim 9 regarding  
 12 all three accused products (*i.e.*, SRX, Sky ATP, and ATP Appliance). Finjan argues that ATP  
 13 Appliance (which was not at issue in the first round of early motions for summary judgment)  
 14 infringes Claim 9, which substantially overlaps with Claim 1, of the '780 patent.<sup>3</sup>

15          Juniper also moves on the issue of damages — that is, according to Juniper, Finjan is  
 16 not entitled to any damages in connection with ATP Appliance because it failed to provide  
 17 actual or constructive notice of infringement in compliance with 35 U.S.C. § 287 before the  
 18 '780 patent's expiration date on November 6, 2017 (Dkt. No. 371 at 2). Section 287 provides  
 19 that:

20          Patentees . . . may give notice to the public that [an article] is  
 21 patented, either by fixing thereon the word "patent" or the  
 22 abbreviation "pat.", together with the number of the patent . . . In  
 23 the event of failure so to mark, no damages shall be recovered by the  
 24 patentee in any action for infringement, except on proof that the  
 25 infringer was notified of the infringement and continued to infringe  
 26 thereafter, in which event damages may be recovered only for  
 27 infringement occurring after such notice.

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28          <sup>3</sup> Finjan does not argue that SRX and Sky ATP infringe Claim 9 under the Court's previously construed term.  
 This order thus only considers ATP Appliance as the accused product in connection with the instant motion.

1 This order agrees with Juniper and thus holds that Finjan cannot recover any damages on the  
 2 ATP Appliance.<sup>4</sup> Further, because Finjan does not oppose Juniper's motion in connection with  
 3 SRX or Sky ATP under the Court's present construction of Claim 1 (and only opposes in  
 4 connection with ATP Appliance), this order finds non-infringement of Claim 9 of the '780  
 5 patent regarding SRX and Sky ATP.

6           **A.       Actual Notice.**

7           Finjan failed to provide Juniper or Cyphort (from whom Juniper acquired ATP  
 8 Appliance) actual notice. Actual notice requires an affirmative communication by the patentee  
 9 to be "sufficiently specific to support an objective understanding that the recipient may be an  
 10 infringer," including a "charge of infringement of specific patents by a specific product or  
 11 group of products." *Funai Elec. Co. v. Daewoo Elecs. Corp.*, 616 F.3d 1357, 1373 (Fed. Cir.  
 12 2010) (citations omitted).

13           Finjan first generally states that Finjan and Cyphort began licensing discussions in  
 14 February 2015, with a follow up letter sent in January 2016 "identifying certain Finjan patents"  
 15 (Dkt. No. 393 at 10–11, 32). That letter, however, did not mention the '780 patent (*see* Dkt.  
 16 No. 392-12). The draft license Finjan relies on similarly failed to specifically mention the '780  
 17 patent (*see* Dkt. Nos. 392-24, 392-26).

18           It next argues that it provided Cyphort notice during a presentation Finjan gave in 2016  
 19 given during their licensing discussions (Dkt. No. 393 at 32). This presentation "introduced  
 20 Finjan and its technology to Cyphort and gave a complete overview of Finjan's history and  
 21 patents" and "the identification of Finjan's patent portfolio" (including the '780 patent) (Dkt.  
 22 No. 392-4 at 11). As Juniper points out, however, that presentation merely noted in general the  
 23 '780 patent as one of the patents previously asserted against other third party defendants (*see*  
 24 Dkt. No. 392-16). At no point during the presentation (under the current record) did Finjan  
 25 specifically charge infringement of the '780 patent against ATP Appliance.

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26  
 27           <sup>4</sup> Finjan argues that the issue of damages is outside the scope of the showdown procedure. This order disagrees.  
 28 Damages are part and parcel to Finjan's claim of infringement. Juniper does not raise the Section 287 issue as a defense  
 against infringement, but rather, now properly moves on the Section 287 issue.

1        During oral argument, Finjan attempted to cobble together a showing of actual notice  
2 by pointing to the various letters, draft license, and presentation. Its attempt falls short. Finjan  
3 argued that the draft license was meant for the entire patent portfolio, which included the '780  
4 patent (as called out in the presentation). But that draft license agreement covered patent rights  
5 that were so broad that they could not provide meaningful notice. Specifically, the draft  
6 license stated that (Dkt. No. 392-26):

7        “Finjan’s Patent Rights” means any issued patent and *any pending patent application anywhere in the world* that Finjan owns or  
8 controls at any time during the term of this Agreement where such  
9 patent or patent application was filed, or claims priority to an  
application filed on, or before the Effective Date, *including but not limited to* all of the patents identified in Exhibit C.

10      Incredibly, Finjan thus would have Cyphort on notice of future patents it does not yet own and  
11 patents Finjan did not bother to identify in “Exhibit C” under its logic.

12      Moreover, Finjan’s reliance on *Novo Nordisk A/S v. Becton Dickinson & Co.*, 96 F.  
13 Supp. 2d 309, 319–20 (S.D.N.Y. 2000), *aff’d*, 304 F.3d 1216 (Fed. Cir. 2002), for the  
14 proposition that actual notice may be satisfied “in the context of the overall dealings between  
15 the parties” is unpersuasive for two reasons (Dkt. No. 393 at 33). *First*, the out-of-district  
16 decision is not binding. Contrary to Finjan’s representations during oral argument, the United  
17 States Court of Appeals for the Federal Circuit did *not* affirm the district court’s decision  
18 regarding the issue of notice, as it was not specifically at issue before the appellate court.  
19 *Second*, *Novo Nordisk* concerned whether accused *products* must be specifically identified as a  
20 matter of law under Section 287. *Novo Nordisk*, 96 F. Supp. 2d at 319–20. In contrast, at issue  
21 in the instant motion is whether Finjan sufficiently identified a specific *patent*. This issue does  
22 not raise similar factual inquiries as in *Novo Nordisk*.

23      Ultimately, Finjan cites no authority blessing such vague “notice” as sufficient. And,  
24 this order finds Finjan’s argument particularly unconvincing where Finjan was perfectly  
25 capable of specifically calling out other patents in its correspondence with Cyphort (*see* Dkt.  
26 No. 392-12). Finjan thus fails to raise a genuine issue of material fact. Accordingly, this order  
27 finds that Finjan failed to provide either Cyphort or Juniper actual notice.  
28

1                   **B. Constructive Notice.**

2                   Nor did Finjan provide constructive notice. An accused infringer bears only “an initial  
 3 burden of production to articulate the products it believes are unmarked ‘patented articles.’ ”  
 4 *Arctic Cat Inc. v. Bombardier Recreational Prod. Inc.*, 876 F.3d 1350, 1368 (Fed. Cir. 2017),  
 5 *cert. denied*, 139 S. Ct. 143 (2018). “Once the alleged infringer meets its burden of  
 6 production, however, the patentee bears the burden to prove the products identified do not  
 7 practice the patented invention.” *Ibid.* “A patentee’s licensees must also comply with  
 8 [Section] 287, because the statute extends to ‘persons making or selling any patented article for  
 9 or under the patentee.’ ” *Id.* at 1366 (quoting *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1111  
 10 (Fed. Cir. 1996)). “Recognizing that it may be difficult for a patentee to ensure his licensees’  
 11 compliance with the marking provisions . . . where third parties are involved, courts may  
 12 consider ‘whether the patentee made reasonable efforts to ensure compliance with the marking  
 13 requirements.’ ” *Ibid.* (quoting *Maxwell*, 86 F.3d at 111–12). “[T]o satisfy the constructive  
 14 notice provision of the marking statute,” a patent owner must show that “*substantially all* of  
 15 [the products covered by the patent] being distributed were marked, and that once marking was  
 16 begun, the marking was substantially consistent and continuous.” *Nike, Inc. v. Wal-Mart  
 Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998) (emphasis added).

18                  Finjan has not met its burden here. *First*, Finjan seemingly attempts to backtrack from  
 19 its prior admission that Juniper gave adequate *Arctic Cat* notice in connection with United  
 20 States Patent No. 8,677,494 (“the ’494 patent”) (which notice was given at the same level of  
 21 detail as for the ’780 patent). Specifically, during trial over Claim 10 of the ’494 patent, Finjan  
 22 explicitly stipulated as follows (Dkt. No. 336 at 289:18–290:1 (emphasis added)):

23                  The Court: I’m asking [about] this *Arctic* notice . . . can you both  
 24 agree that that was given so that we don’t have to  
 complicate the trial with yet another issue?

25                  Ms. Kobialka: Yeah, and that’s not a jury issue to decide whether or  
 not that notice was given in the litigation.

26                  THE Court: All right. So if I just tell you right now that you’ve got  
 27 to prove notice, you are okay with that?

28                  Ms. Kobialka: Yes.

1        *Second*, none of Finjan’s newly raised arguments are persuasive. It first contends that  
2 Juniper failed to meet its burden of production because Juniper did not provide any “specific  
3 unmarked products” that it believes practice the ’780 patent (Dkt. No. 393 at 34). Not so. This  
4 order finds that Juniper met its burden of production when it notified Finjan of the following  
5 products it believed practiced the ’780 patent (Dkt. No. 371-11 at 3):

- 6            • **Finjan, Inc.**: Vital Security Products
- 7            • **WebWasher** (currently owned by McAfee, Inc.): WebWasher  
8            SCM Suite Products
- 9            • **Sophos, Inc.**: Sophos Live Protection Products
- 10          • **Aladdin Knowledge Systems, Inc.**: eSafe Products
- 11          • **Webroot Inc.**: Webroot Web Security Software Products,  
12            Webroot Email Security Products
- 13          • **Licensed products from Veracode, Inc., Avira Holding GmbH  
14            & Co. KG, Panda Security, Barracuda Networks, Inc.,  
15            AVAST, F-Secure Corporation, Microsoft Corporation, Intel  
16            Corporation, McAfee, Inc., M86 Security, and Trustwave**

17        Finjan complains that all Juniper provided was a list of “one third party entity that was found  
18 to have infringed the ’780 Patent in the district court and the appellate court (Secure  
19 Computing), two of Finjan’s licensees (Sophos and Webroot) and a non-licensee third party  
20 (Aladdin), and generally describe[d] some product categories that they offer” (Dkt. No. 393 at  
21 34). It asserts that Juniper should have provided more specific information, such as “the  
22 versions of the products and the relevant timeframe during which the products were allegedly  
23 available” (*ibid.*). But Finjan offers no authority requiring that level of detail in satisfying the  
24 initial burden of production.

25        In fact, meeting this initial burden of production “is a low bar.” *Arctic Cat*, 876 F.3d at  
26 1368. The point of requiring an accused infringer to notify a patent owner of “specific  
27 unmarked products” it believes practice the asserted patent is to avoid “a large scale fishing  
28 expedition and gamesmanship,” as otherwise a patent owner’s “universe of products for which  
it would have to establish compliance would be unbounded.” *Ibid.* Here, at least with respect  
to the first five specific parties and their products listed by Juniper, Finjan does not sufficiently

1 show how that the list of products provided by Juniper risks gamesmanship. Finjan merely  
 2 asserts that those product categories “include hundreds of different versions” (Dkt. No. 393 at  
 3 34). But versions of products are often easily grouped together and addressed by patent  
 4 owners themselves.<sup>5</sup>

5 Finjan next argues that even assuming Juniper met its initial burden of production, it is  
 6 still not entitled to summary judgment because the third parties identified by Juniper “either do  
 7 not offer products that practice . . . or flatly deny that they practice” the ’780 patent (despite  
 8 Finjan’s allegations that those licensees *did* practice the patent at the time during the relevant  
 9 litigation) (*ibid.*). But whether a licensee does not believe it is practicing the asserted patent is  
 10 irrelevant to *Finjan’s* burden of proving that the identified products do not practice the patent  
 11 (and were thus not required to be marked).<sup>6</sup> Finjan’s conclusory assertion that “[a]t a  
 12 minimum, there is a factual dispute regarding whether a licensee was required to mark because  
 13 it denied infringement in the license” is thus unpersuasive (as are the district court decisions  
 14 Finjan cites, as they all pre-date *Arctic Cat*, which shifted the burden of proof from the alleged  
 15 infringer to the patent owner) (*ibid.*). And, Finjan gives no authority for the proposition that  
 16 simply because certain licensees denied admission of liability when it entered into licensing  
 17 agreements with Finjan, those licensees were not required to mark as a matter of law (*ibid.*).  
 18 Rather, the appellate court in *Arctic Cat* held that where the accused infringer “identified  
 19 fourteen unmarked [third party licensed products], which it argued fell within the patent  
 20 claims, it was *the patentee’s burden to establish compliance with the marking statute* — that  
 21 these products did not fall within the patent claims.” *Arctic Cat*, 876 F.3d at 1367 (emphasis  
 22 added). This burden was imposed despite the fact that the licensing agreement between the  
 23 patent owner and third party licensee “specifically state[d] [that the third party licensee] ‘shall

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25       <sup>5</sup> Though the United States Court of Appeals for the Federal Circuit in *Arctic Cat* found that the accused infringer  
 26 met its initial burden of production where it “identified fourteen [third party licensee products] from three versions of its  
 27 Aquatrax series sold between 2002 and 2009,” the appellate court explicitly noted that it was not determining “the minimum  
 28 showing needed to meet the initial burden of production.” *Arctic Cat*, 876 F.3d at 1368.

<sup>6</sup> In fact, a jury *did* find that Sophos’s products infringe the ’780 patent, and Finjan merely asserts that it “entered  
 29 into a patent license agreement on March 30, 2017 before the Federal Circuit heard Sophos’s appeal of infringement” (Dkt.  
 Nos. 371 at 24; 393 at 36).

1 have no obligation or requirement to mark' its licensed products." *Id.* at 1366. Nor did the  
 2 appellate court provide any caveats to the patent owner's burden of proof where the accused  
 3 infringer denies infringement.

4 There is no dispute that Finjan did not require any of its licensees to mark — it readily  
 5 admits that "none of Finjan's licenses contain a marking requirement" (Dkt. No. 357 at 15).  
 6 Nor is there any dispute that none of Finjan's licensees actually marked their products. And,  
 7 Finjan does not even attempt to offer evidence that the identified products do not practice the  
 8 '780 patent in support of its burden of proof. Accordingly, this order finds that Finjan failed to  
 9 give constructive notice of the '780 patent.

10 \* \* \*

11 In its opposition Finjan only argues that it provided notice for the ATP Appliance (*see*  
 12 Dkt. No. 393 at 31–36). Because Finjan failed to provide actual or constructive notice of  
 13 infringement as to the '780 patent regarding the ATP Appliance product, notice of  
 14 infringement could only occur at the filing of the complaint. *See* 35 U.S.C. § 287(a) ("Filing  
 15 an action for infringement shall constitute such notice."). Finjan filed the instant action in  
 16 September 2017. The '780 patent expired November 6, 2017. Finjan, however, did not move  
 17 for leave to add the ATP Appliance to the instant action until May 2018. As such, this order  
 18 agrees with Juniper that Finjan did not provide actual notice regarding the ATP Appliance until  
 19 it served its infringement contentions in March 2018 — four months after the '780 patent  
 20 expired — and is accordingly barred from recovering any damages as to the ATP Appliance.  
 21 Juniper's motion for summary judgment of non-infringement in connection with SRX and Sky  
 22 ATP and on damages in connection with ATP Appliance is therefore **GRANTED**.<sup>7</sup>

23 **3. JUNIPER'S MOTION TO STRIKE.**

24 Juniper concurrently moves to strike Finjan's allegedly new infringement theories in  
 25 connection with the '154 patent (Dkt. No. 391). In light of this order's holding of non-

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<sup>7</sup> In light of this holding, this order finds moot the issue of non-infringement as to ATP Appliance.

1 infringement, Juniper's motion to strike is **DENIED AS MOOT**. In the event another '154 patent  
2 claim becomes at issue, Juniper may bring a fresh motion to strike.

3 **CONCLUSION**

4 For the foregoing reasons, Finjan's motion for summary judgment of infringement of  
5 Claim 1 of the '154 patent is **DENIED**. Juniper's motion for summary judgment on Claim 9 of  
6 the '780 patent and damages is **GRANTED** to the extent stated above and its motion to strike is  
7 **DENIED AS MOOT**. Both sides are **ORDERED TO SHOW CAUSE** in writing by **MAY 13 AT NOON**  
8 why summary judgment should not be granted in favor of Juniper with replies by **MAY 16 AT**  
9 **NOON**.

10 Further, the trial currently set for July 29 is hereby **VACATED**. Instead, a final pretrial  
11 conference is hereby **SET** for **OCTOBER 9 AT 2 P.M.** and trial on all remaining patents and  
12 issues is hereby **SET** for **OCTOBER 21 AT 7:30 A.M.** The Court invites counsel to submit to the  
13 Court by **MAY 15 AT NOON** what issues must be addressed in the October trial.

14  
15 **IT IS SO ORDERED.**

16 Dated: May 8, 2019.

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18 WILLIAM ALSUP  
19 UNITED STATES DISTRICT JUDGE  
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